

# Office Action Summary



UNITED STATES DEPARTMENT OF COMMERCE

## Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO. 09/091,704	FILING DATE 10/13/98	FIRST-NAMED INVENTOR FRANKE	ATTORNEY DOCKET NO. 966340USWO
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09/091,704 10/13/98 FRANKE K 966340USWO

DATE OF THIS COMMUNICATION 028552

IM22/4019

MERCHANT & GOULD P

P.O. BOX 2903

MINNEAPOLIS, MN. 55402-0903

1774

DATE MAILED: 10/19/01

### Status

1) ☒ Responsive to communication filed on 09/12/00

2) ☐ This action is FINAL. 2b) ☒ This action is not final

Please find below and/or attached an Office communication concerning this application or proceeding.

### Disposition of Claims

4) ☒ Claim(s) 1, 4-15, 18-26, and 65-68

Commissioner of Patents and Trademarks

Of the above, claim(s) 1, 4-14, 65 and 66 is/are withdrawn from consideration

5) ☐ Claim(s) is/are allowed

3) ☒ Claim(s) 15, 18, 19, 22-26, and 65 is/are rejected

7) ☒ Claim(s) 20, 21, and 67 is/are objected to

9) ☐ Claims are subject to restriction and/or election

### Application Papers

9) ☐ The specification is objected to by the Examiner

10) ☐ The drawing(s) filed on is/are objected to by the Examiner

11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved

12) ☐ The oath or declaration is objected to by the Examiner

### Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d)

a) ☐ All b) ☐ Some\* c) ☐ None of

1 ☐ Certified copies of the priority documents have been received

2 ☐ Certified copies of the priority documents have been received in Application No

3 ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))

\*See the attached detailed Office action for a list of the certified copies not received

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e)

### Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s)

16) ☐ Source of Draftsperson's Patent Drawing Review (PTO-146)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s)

20) ☐ Other

# Office Action Summary

Application No.  
**09/091,704**

Applicant(s)  
**Franke**

Examiner  
**Betelhem Shewareged**

Art Unit  
**1774**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 8, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 4-15, 18-26, and 65-68 is/are pending in the application.
- 4a) Of the above, claim(s) 1, 4-14, 65, and 66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15, 18, 19, 22-26, and 68 is/are rejected.
- 7) ☒ Claim(s) 20, 21, and 67 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Applicant's response filed on 08/08/2001 has been fully considered. Claims 1, 4-15, 18-26, 65-68 are pending.

#### ***Election/Restriction***

2. Applicant's election with traverse of Group II in Paper No. 21 is acknowledged. The traversal is on the ground(s) that requiring restriction at this stage of prosecution is improper and there is no burden on the Examiner in examining both inventions. This is not found persuasive because initially the case was examined by another Examiner, and the current Examiner did not get a chance to review the claims as originally claimed, however, the Examiner believes that applying lack of unity of invention requirement is proper. Note: Applicant did not choose any special technical before the Office Action mailed on 04/10/2001.

The requirement is still deemed proper and is therefore made FINAL.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 22, 23, 26 and 68 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- a. In claims 22 and 23, the use of the term "fine" renders the claims ambiguous. The term is neither defined in the specification nor does it have a well defined meaning in the art. At what point is the powder "fine," i.e., what is the necessary degree of fineness value?
- b. Claim 26 is dependent upon a canceled claim 1.
- c. In claim 68, elastomer is misspelled as "elasyomer".

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 15, 18, and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Olsen (US 5,916,399).

Olsen discloses a method of making a transfer, the method comprises providing a base sheet having heat softenable layer made of silicone, printing at least one color layer over the base sheet, screen printing a transparent polyurethane (PU) elastomer extender layer over the at least one color layer, and sprinkling hot-melt powder over the PU extender layer while the PU extender layer is still wet. The PU extender layer is applied in a form of solution having polyurethane and organic solvent. (Abstract; Fig. 2; col. 3, line 27 thru col. 4, line 21; col. 5, lines 19-22 and 44-46; and col. 6, lines 35-61). The claimed printing apparatus in claim 25 is not given patentable weight

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because these claims are directed to process. The limitations of the claims are met by the disclosure of the prior art.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 15, 18, 19, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen (US 5,916,399).

Olsen discloses a method of making a transfer, the method comprises providing a base sheet having heat softenable layer made of silicone, printing at least one color layer over the base sheet, screen printing a transparent polyurethane (PU) elastomer extender layer over the at least one color layer, and sprinkling hot-melt powder over the PU extender layer while the PU extender layer is still wet. The PU extender layer is applied in a form of solution having polyurethane and organic solvent. (Abstract; Fig. 2; col. 3, line 27 thru col. 4, line 21; col. 5, lines 19-22 and 44-46; and col. 6, lines 35-61). The claimed printing apparatus in claim 25 is not given patentable weight because these claims are directed to process. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add a white pigment in the extender layer if a white extender layer is desired. Adding a dye, a pigment or a color changing agent into any material is a well known art and a conventional method.

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*Allowable Subject Matter*

9. Claims 20, 21 and 67 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

10. Any inquiry regarding this communication or earlier communications from the Examiner should be directed to Betelhem Shewareged, whose telephone number is (703) 305-0389. The Examiner can normally be reached Monday to Thursday from 7:30 AM to 6:00 PM.

A facsimile center has been established in Group 1700, Crystal Plaza 3, 8th floor, reception area. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 305-3599 (for official after final faxes) or (703) 305-5408 (for all other official faxes). This location should be used in all instances when faxing any correspondence to Art Unit 1774. Use of the Group 1700 center will facilitate rapid delivery of materials to Examiners in Art Unit 1774.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



BS *BS*

October 11, 2000.

BRUCE H. HESS  
PRIMARY EXAMINER